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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,637	08/07/2001	Larry Bowen	00417.00003	9687

22907 7590 10/22/2003

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WASHINGTON, DC 20001

EXAMINER

WALLS, DIONNE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,637

Applicant(s)

BOWEN ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on August 5th, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 110-113 and 115-130 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 110-113, 120 and 125-130 is/are rejected.
- 7) ☒ Claim(s) 115-119 and 123-124 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

Claim 122 is objected to because it depends from cancelled claim 121.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 110-113, 120, and 125-130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (US. Pat. No. 4,915,117).

Ito discloses a sheet for holding tobacco, said sheet formed of ceramic fibers or powder which may include zirconia, alumina or titanium oxide (corresponding to the claimed "non-combustible material/oxygen storage component/group IVB metal oxide/catalyst"); glass fiber (corresponding to the claimed "sheet reinforcement"), singly or in combination with aluminoborosilicate (corresponding to the claimed "oxygen storage component/catalyst/aluminum silicates"); a binder, which can be either organic or inorganic and can consist of starch, silica gel, rubber-type adhesives or natural resins (which also corresponds to the claimed "sorbent/porous metal oxide/plastic/cellulose materials"); and cellulose pulp fiber (corresponding to the claimed "organics"). The sheet comprised of such fibers/additives such that upon smoking of the cigarette having the sheet as a wrapper, no harmful organic substances are produced (corresponding to the claimed "activating said sheet material...at a temperature of a high temperature

cigarette burn zone”) (see entire patent). While there may be no explicit statement that the cellulosic pulp fiber or organic binder is combustible at the high-temperature cigarette burn zone, it would follow that since the cellulosic pulp/organic binder is derived from a cellulose/wood source (which are themselves combustible materials) said materials would, obviously, also burn or combust when subjected to high-temperatures.

***Allowable Subject Matter***

3. Claims 115-119 and 123-124 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

4. Applicant's arguments filed August 5th, 2003 have been fully considered. While the arguments that were presented with respect to the Snaidr et al reference were persuasive, those directed to the Ito reference were not.

- Applicant argues that Ito clearly does not disclose a cigarette that has organics that are combusted when the cigarette is burning, as recited in the claims, since the “organics” that Ito believes cause the above-mentioned problems are removed long before the cigarette is ever smoked. However, the examiner disagrees and believes that Ito's constituent of cellulose pulp fibers is what corresponds to the claimed “organics”. Specifically, Ito claims a cigarette comprising a thin sheet for holding tobacco, said thin sheet comprising a mixture of wood pulp (organic) and ceramic fibers. It follows that the organic portion, i.e. wood pulp, of the cigarette sheet would burn

during smoking. The Examiner finds no indication in Ito of an intent to "remove" all the organics from said sheet before the wrapper is applied to the smoking rod and prior to the smoking article being smoked. All that the Examiner believes is disclosed by Ito is the formation of a cigarette sheet that produces no harmful organic substances from the paper fiber which it includes because the organic fibers have been "thermally decomposed", which is a completely different issue from organic material that has been "removed". Examiner contends that the organic material is still there, since "thermal decomposition" does not involve combustion (just heating in absence of air); therefore, upon subsequent burning/combusting of the sheet, the resulting organic material is unable to produce harmful organic substances. Therefore, since the Examiner believes that even after thermal decomposition, organic material is still present, it follows that such material will burn, even though harmful substances may no longer be produced. The rejection of claims 110-113 over the Ito reference is still considered proper.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

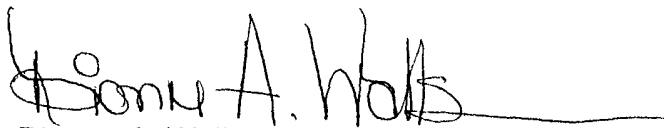
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", followed by a horizontal line.

Dionne A. Walls  
October 18, 2003